

Remarks

Claims 1-6, 10-12, and 16-21 are amended. The amendments to these claims are for clarification purposes only and not intended to limit the scope of these claims in any way. New claims 23-32 are added to more completely claim the invention.

Three replacement sheets are enclosed. In Fig. 2, the reference designator "200" is added. In Figs. 5 and 7, the reference designator for the pager network is changed to "522". No new matter is added.

Claims 1-22 are rejected under 35 U.S.C § 103 as being obvious over U.S. Patent 6,542,750 to Hendrey et al. ("Hendrey") in view of U.S. Patent 6,135,354 to Kubon ("Kubon"). Reconsideration of the application in light of the remarks below is respectfully requested.

In order to establish a prima facie case of obviousness, there must be shown: 1) a suggestion or motivation in the references or in the knowledge of one with ordinary skill in the art, to modify or combine the references and 2) the prior art references must teach or suggest all of the claim limitations. M.P.E.P. §706.02(j). Both elements are missing here.

Among the limitations of independent claim 1, which are neither shown nor suggested in the art of record are:

a coupon depository coupled to the server process capable of storing a plurality of coupons, the coupons including an encoding of a barcode image. . . .

Similarly, among the limitations of independent claim 10, which are neither shown nor suggested in the art of record are:

a communication receiving process responsive to communication signals from the server process for receiving coupon information from the server process, the coupon information including an encoded barcode image . . . .

Among the limitations of independent claim 16, which are neither shown nor suggested in the art of record are:

an electronic coupon clearinghouse coupled to the network and containing a plurality of electronic coupons, the electronic coupons including an encoded barcode image. . . .

The Office Action agrees that the above limitations are not shown in Hendrey and points to Kubon as showing “a barcode image processing system”. See, e.g. Office Action. page 3.

Yet, even the combination of these two references does not show a coupon including a bar code image as is claimed. A combination of the asserted teachings of Hendrey and Kubon yields coupons and a barcode image system – not a coupon including a barcode image.

Additionally, the cited motivation for combining the references is untenable. The Office Action states that a person with ordinary skill in the art would be motivated to combine the

references "because such modification would verify and report unauthorized users within the telecommunication network." Office Action, page 3. It is not clear how combining coupons with a barcode imaging system relates in any way to verifying and reporting unauthorized users in a network. As such, Applicant asserts that one with ordinary skill in the art would not be motivated to combine the references as suggested in the Office Action. Without such a motivation, a prima facie case of obviousness cannot be made.

Moreover, the Office Action has failed to show a motivation in the cited references for combining the disclosures of Hendrey and Kubon. See, M.P.E.P. §2143. A motivation is simply asserted without any indication as to its source. If the Examiner persists in stating that such motivation is known, Applicant requests that the Examiner set forth a reference which shows such a motivation or that the Examiner submit an Examiner's affidavit indicating that such knowledge is known by one of ordinary skill in the art so that Applicant may have the opportunity to rebut such an assertion. See M.P.E.P. § 2144.03

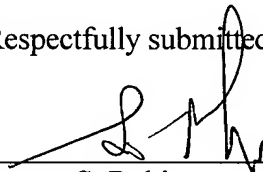
Further, independent claim 1 also recites "a coupon depository. . .storing a plurality of coupons" and independent claim 16 recites "a coupon clearinghouse. . . containing a plurality of electronic coupons." The Office Action points to Hendrey as showing these limitations. However, Hendrey only discusses the possibility of sending coupons to a portable device. See, e.g., column 15, lines 35-46. There is no disclosure of a depository or clearinghouse storing or containing a plurality of coupons as claimed.

Therefore, it is asserted that claims 1, 10 and 16 are patentable over even the combination of Hendrey and Kubon. Dependent claims 2-9, 11-15 and 17-22 include the above referenced limitations of independent claims 1, 10 and 16 respectively and include additional recitations which, when combined with the limitations of claims 1, 10 and 16 are also neither disclosed nor suggested in the art of record. It is asserted that these claims are patentable as well.

Reconsideration of the rejection of claims 1-22 under 35 U.S.C. §103 is respectfully requested in light of the remarks above.

Respectfully submitted,

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